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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,115	04/23/2004	Loren Eckart	59683.000002	9016

7590 01/23/2009
HUNTON & WILLIAMS
Suite 1200
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Washington, DC 20006-1109

EXAMINER

JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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01/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/830,115	Applicant(s) ECKART ET AL.	
	Examiner GREGORY JOHNSON	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,13,15-25,27-33,35-42,44,46-55,57-63 and 100-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12,13,15-25,27-33,35-42,44,46-55,57-63 and 100-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Request for Continued Examination (RCE) filed December 30, 2008.

Status of Claims

2. Claims 1, 24, 33, 55 and 100-102 have been amended. Claims 2, 11, 14, 26, 34, 43, 45, 56 and 64-99 have been canceled during applicant prosecution. Claims 3, 5, 7-10, 12-13, 15-16, 21-23, 25, 27-28, 30-32, 35-42, 44, 46-47, 52-54, 57-59 and 61-63 are as previously presented. Claims 4, 6, 17-20, 29, 48-51 and 60 are original. Claim 103 is new. Claims 1, 3-10, 12-13, 15-25, 27-33, 35-42, 44, 46-55, 57-63 and 100-103 are pending.

Response to Amendment

3. The declaration under 37 CFR 1.132 filed July 29, 2008 is sufficient to overcome the rejection of claims 1, 3-10, 12-13, 15-25, 27-33, 35-42, 44, 46-55, 57-63 and 100-103 based upon the general knowledge in the art of accounting the meaning of “financial statement” and “general ledger.” The Lewis (US Pat. 6,513,019) reference discloses “financial statement” in a different context (i.e. in relation to financial transactions).

Response to Arguments

4. Applicant's arguments with respect to claims 1, 3-10, 12-13, 15-25, 27-33, 35-42, 44, 46-55, 57-63 and 100-103 have been considered but are moot in view of the new grounds of rejection.

Claim Objections

5. Claim 100 was previously objected to; however, in view of Applicants amendment the objection has been withdrawn.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33, 35-42, 44 and 46-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There are four (4) statutory categories for claiming an invention and they are as follows:

- 1) process or method (which may be a process of making something or a process of using something),
- 2) a machine or apparatus,
- 3) a manufacture (article), and
- 4) a composition of matter.

In regards to the independent claim 33, the Examiner has interpreted the claim as being drawn to the apparatus statutory category because of the use of "system" in the preamble. However, the body of the claim does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure (e.g. hardware, machine or apparatus) that is performing the

function. Applicant's claimed limitation consist of modules and a database (software, hardware, firmware, or a combination therein; ¶0046); these that do not distinctly describe the structure of the system (i.e. apparatus). Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 3-10, 12-13, 15-25, 27-33, 35-42, 44, 46-55, 57-63 and 100-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creeden et al., Pub. No. 2004/0122756 (hereinafter Creeden), in view of MaGuire, III et al., Pub. No. 2004/0059651 (hereinafter MaGuire), Minninger, Pat No. 6,993,717 (hereinafter Minninger), Lavorgna, JR. et al., Pub. No. 2002/0184043 (hereinafter Lavorgna) and Elizabeth K Keating, "Reengineering nonprofit financial accountability: Toward a more reliable foundation for regulation" (hereinafter Keating).

As to claim 24, Creeden discloses a system and method for automated management of financial statement information associated with at least one business, the method comprising:

- receiving financial statement information at a remote data processing system as an electronic data file uploaded by an agent of a submitting business via a graphical user interface (GUI), the financial statement information associated with the submitting business and originating from an accounting system used by the submitting business to maintain its general ledger accounting records, the financial statement information having a first format based on a first set of performance classifications and collectively corresponding to the overall financial state of the submitting business (Abstract; ¶0001, ¶0005-0006 and ¶0099; via receiving at the server system business information relating to at least one second business entity from the client system);
- aggregating the financial statement information with financial statement information associated with at least one other business, thereby creating a database of standardized company financial statement information (¶0008; via maintains a database with RM information for at least one of each second business entity and a selected group of second business entities); and
- providing the at least one performance report to at least one requesting party via the GUI (¶0106; via retrieving component generates reports requested by the user through client system in a pre-determined format and a display

component used to display report on a client system's graphical user interface).

Creeden does not explicitly disclose that the financial statement information is associated with a non-public business.

However, Keating teaches that the average nonprofit organization is relatively small, mission focused, and often cash constrained. Keating further teaches that some nonprofits maintain cash-basis records during the year and hire an external accounting service to convert the books to an accrual basis at year-end (page 4, last ¶).

Creeden discloses a method for managing the financial information of a second business entity by a first business entity. However, Creeden is silent on the second business entity being either private or public. Keating teaches that some nonprofit organizations (i.e. private entities) hire an external accounting service to convert their books.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the business information management system as disclosed by Creeden, the use of a private entity (e.g. nonprofit organization) as the second business entity as taught by Keating, since the claimed invention is simply a substitution of one known element for another (i.e. public vs. private business), and one of ordinary skill in that art would have recognized that the results of the substitution were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Neither Creeden nor Keating discloses or teaches the following limitation; however, this limitation is taught by MaGuire:

- converting the financial statement information from the first format to a second standardized format based at least in part on a mapping between one or more performance classifications of the first set of performance classifications and one or more corresponding performance classifications of a second set of performance classifications (Abstract).

Creeden discloses a method for managing the financial information of a second business entity by a first business entity. And MaGuire teaches a method for converting the financial information of a second business entity into a format supported by the first entity.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the Creeden and Keating combination, the automated method of converting journal entries as taught by MaGuire, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Neither Creeden, Keating nor MaGuire discloses or teaches the following limitations:

- automatically selecting at least one automated software program for the financial statement information associated with the submitting business with the data processing system (e.g. pre-defined translation templates);

- converting, using the at least one automated software program executing on the data processing system.

However, Minninger teaches in a data transformation system where a report is generated from the current system, a translation tool can be used for mapping and translating the data to the receiving systems' conversion format. By developing standard reports and pre-defined translation templates, data from one system's application can be converted easily, repeatedly and efficiently (Abstract).

Creeden discloses a method for managing the financial information of a second business entity by a first business entity. And Keating and MaGuire teach that financial information is converted from one format into a second format.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the Creeden, Keating and MaGuire combination, the method of using a pre-defined translation templates (i.e. conversion maps) as taught by Minninger, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Neither Creeden, Keating, MaGuire nor Minninger discloses or teaches the following limitations:

- analyzing, using at least one automated software program executing on the data processing system, the financial statement information based at least in part on one or more performance metrics; and
- automatically creating at least one performance report based on results of the analysis of the financial statement information with the data server.

However, Lavorgna teaches a system and method for managing business metrics which facilitates electronic creation, submission, analysis, integration, and automation of business metric information and web-based business metrics reporting. Lavorgna teaches a computerized method for creating, storing and using business metrics in managing, monitoring, reporting or directing business unit operations. This computerized method provides a capability to create and manage such business metrics, and reduces the potential for mistakes in manually (via human) handed business metrics. Lavorgna teaches that a business metrics record may be compiled or otherwise acted upon by the system in accordance with predetermined criteria to provide an analysis record or a reporting record (§§0076, §§0079 and §§0081-0083).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Lavorgna within the Creeden, Keating, MaGuire and Minninger combination for the motivation to provide a management tool that for capturing, analyzing, reporting and assessing business metrics (§§0003).

As recited above, Creeden discloses aggregating the financial statement information. Keating teaches private financial information and converting the financial

statement information. and MaGuire teaches converting financial statement information. And Lavorgna teaches analyzing business metrics, such as financial statements. Therefore, the combination of Creeden, Keating, MaGuire and Lavorgna discloses and teaches the following limitations:

- aggregating the converted financial statement information;
- creating a database of standardized private company financial statement information; and
- analyzing the converted financial information.

As to claim 1, Creeden discloses a method for automated management and standardization of financial statement information associated with at least one business comprising:

- storing financial statement information as electronic data on the data processing system, the financial statement information having a first format based on a first set of performance classifications (Abstract; ¶¶0001, ¶¶0005-0006, ¶¶0099 and claim 39; via storing the business information received at the server system in the centralized database; receiving component that receives information in a pre-determined format established for inputting said business information); and
- automatically providing at least a portion of the at least one electronic report to at least one requesting party (¶¶0006 and ¶¶0095; via provides RM information in response to an inquiry by providing a (electronic) report to at

least one managerial user within the CF Business summarizing the review of RM information for an Analyzed Business).

The remaining limitations of claim 1 are equivalent to the limitations of claim 24 above, and are therefore rejected on the same grounds.

As to claim 33, the limitations are equivalent to the limitations of claims 1 and 24 above, and are therefore rejected on the same grounds.

As to claim 55, Creeden discloses a system for automated management of financial statement associated with at least one business, the system comprising:

- one or more networked servers adapted to (Abstract; via server system and client system):
- operate a website having one or more web pages (see Fig. 3);

The remaining limitations of claim 55 are equivalent to the limitations of claims 1, 24 and 33 above, and are therefore rejected on the same grounds.

As to claim 100, Creeden discloses a method for automated management of private company financial statement information comprising:

- receiving at a network-based data processing system financial statement information as an electronic data file upload, the financial statement

- information containing financial statement information associated with a business, the financial statement information comprising data taken from that business' general ledger accounting system, having a user-defined format (e.g. first format, such as Keating's cash-basis records) based on a first set of performance classifications corresponding to a set of financial accounts, and collectively corresponding to the overall financial state of the submitting business (Abstract; ¶0001, ¶0005-0006 and ¶0099; via receiving at the server system business information relating to at least one second business entity from the client system); and
- generating at least one electronic report based on the analyzing, wherein generating a report comprises generating a web page-based analysis dashboard visualizing results of the analyzing (¶0006, ¶0095-0096; via providing a report of the review results by transmitting an electronic report to the managerial user system), the dashboard detailing at least one historical trend for one or more performance metrics associated with the business for the private business (¶0092, ¶0174, ¶0177 and at least Figures 7-12).

The remaining limitations of claim 100 are equivalent to the limitations of claims 1, 24, 33 and 55 above, and are therefore rejected on the same grounds.

As to claim 101, Creeden discloses a network-based business performance information management system comprising:

- a computer system accessible on a computer network and adapted to (Abstract; via server system):
- generate an alert if results of analyzing indicates that at least one performance metric of the performance information varies from a corresponding predetermined value by more than an adjustable threshold set by a recipient of the alert (¶0199; via An Informative Alert is an alert sent to an account manager within the CF Business to notify the account manager of possible changes in the overall deal that include, but are not limited to, the credit structure, collateral performance, risk ratings, and financial performance of the Analyzed Business. An informative alert has an thresholds).

The remaining limitations of claim 101 are equivalent to the limitations of claims 1, 24, 33, 55 and 100 above, and are therefore rejected on the same grounds.

As to claim 102, the limitations are equivalent to the limitations claims 1, 24, 33, 55, 100 and 101 above, and are therefore rejected on the same grounds.

As to claims 3-4, 7-10, 12-13, 15-17, 22-23, 25, 28, 31-32, 35-36, 39-42, 44, 46-48, 53-54, 57-59 and 62-63, they are rejected using the same rational used in rejected claims 1, 24, 33, 55, 100-102.

As to claims 5, 18, 37 and 49, Creeden does not disclose the following limitation; however, Lavorgna teaches the limitation:

- wherein the predetermined value includes a target value for the at least one performance metric (¶0049 and ¶0297-0298).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Lavorgna within the Creeden, Keating, MaGuire and Minninger combination for the motivation to provide a management tool that for capturing, analyzing, reporting and assessing business metrics (¶0003).

As to claims 6, 19-21, 29-30, 38, 50-52 and 60-61, Creeden discloses the following limitations:

- wherein the predetermined value includes a value representative of an industry average for the at least one performance metric (claim 9; via industry benchmarks);
- wherein the alert is delivered via at least one of a group comprising: an email; a facsimile; a voice message; and a text message (¶0006, ¶0100 and ¶0114; via electronic message); and
- delivering at least a portion of the converted financial statement information to a requesting party as one or more data files having a format compatible with software operated by the at least one requesting party (¶0106; via retrieving

component generates reports requested by the user through client system in a pre-determined format).

As to claim 103, Creeden does not disclose the following limitations:

- generating a conversion map including providing a graphical user interface displaying user-defined performance classifications, standard performance classifications and indicators of correspondences therebetween,
- receiving user input through a selected indicator to correlate one or more user-defined performance classifications to one or more respective standardized performance classifications, and
- creating or modifying the conversion map according to the user input.

However, Minninger teaches in a data transformation system where a report is generated from the current system, a translation tool can be used for mapping and translating the data to the receiving systems' conversion format. By developing standard reports and pre-defined translation templates, data from one system's application can be converted easily, repeatedly and efficiently (Abstract).

Creeden discloses a method for managing the financial information of a second business entity by a first business entity. And Keating and MaGuire teach that financial information is converted from one format into a second format.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the Creeden, Keating and MaGuire combination, the method of using a pre-defined translation templates (i.e. conversion

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maps) as taught by Minninger, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner, Art Unit 3691